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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/460,361 | 12/13/1999 | AKIRA UTSUMI | | 2392 |

7590 02/24/2004
 Jay P. Lessler
 Darby & Darby, P.C.
 805 Third Avenue
 New York, NY 10022

EXAMINER

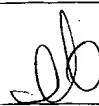
PRATT, CHRISTOPHER C

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1771

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--|--|--|
| <p align="center">Office Action Summary</p> | Application No. 09/460,361 | Applicant(s) AKIRA UTSUMI  | |
| | Examiner Christopher C Pratt | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13 and 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed 12/16/03 have been entered and carefully considered. Applicant's amendment is not found to patently distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-4, 6-13, and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemoto (6102465) in view of Nagata (6312542).

Applicant argues that the instant rejection fails to teach the thickness of the rigid layer. However, as applicant points out, Nagata teaches the total thickness of the laminate to be from 2-80mm (col. 1 and col. 6, lines 9-16). Applicant argues that this teaches away from forming the rigid layer to have a thickness of less than 2mm.

It is the examiner's position that it would have been obvious to a person having ordinary skill in the art to modify the thickness of the layers from .6 to 2mm. Nagata teaches the total thickness of the laminate to be 2mm. Therefore, the thickness of the individual layers would have to be below 2mm. The skilled artisan would have been motivated to utilize a thickness from .6 to 2mm in order to achieve Nagata's thickness teachings. Modifying the thickness of the layers is well within the ordinary skill in the art

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and would have been done to optimize the properties of the laminate and to render the laminate suitable for fitting into various applications.

Applicant argues that it would not have been obvious to modify the tensile strength of the laminate. As previously set forth, Applicant's claimed tensile strength may be inherent in the laminate of Nemoto. In the alternative, she skilled artisan would have been motivated to increase tensile strength by the desire to create a superior low spring layer.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pratt whose telephone number is 571-232-1480. The examiner can normally be reached on Mon-Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher C. Pratt
February 17, 2004